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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,180	08/28/2003	John T. LaJoie	FAT-06-5559	5947
28465 7590 08/05/2008 PATENT GROUP C/O DLA PIPER US LLP 203 N. LASALLE ST., SUITE 1900 CHICAGO, IL 60601				
EXAMINER				
SQUIRES, ELIZA A				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/650,180

**Applicant(s)**

LAJOIE ET AL.

**Examiner**

Eliza Squires

**Art Unit**

4156

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 8/28/2008

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "190" has been used to designate both the filter and the "Commitment Production Process" in figure 1, the "Commitment Production Process" is referred to in the specification with reference character "200". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "200" has been used to designate both "Commitment Production Process" and "Launch Application" in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 3 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 3 and 5 are directed toward non-statutory subject matter, a series of abstract steps. In order for a method to be considered a "process" under 35 U.S.C. 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101 and is nonstatutory subject matter. The claims recite no substantive tie to another statutory class in the body of the claims, therefore, the claims are rejected for being non-statutory.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of the claim recites a system; however the body of the claim recites a database, clauses, a filter, and a user interface which are not system components. It is unclear as to the statutory class the claim is directed to.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,028,047 to *Boulmakoul et al.* in view of SMS website retrieved on the site <http://web.archive.org/web/20000815054815/www.smscorp.com/> for the date 8/15/2000.

5. **As to claim 1**, *Boulmakoul* discloses an automated system for producing a commitment comprising:

a first set of multi-locality textual clauses specifying minimal requisite language for a title commitment and a second set of multi-locality textual clauses specifying minimal exclusionary language for a commitment (column 1 lines 35-61);

a filter for reducing said first and second sets to locality-specific textual clauses of minimal requisite and exclusionary language (column 1 lines 35-61),

a user interface configured to present said locality specific textual clauses in selectable form (column 2 lines 4-8); and

a commitment processor programmed to generate a commitment based upon selected ones of said locality specific textual clauses (column 1, lines 35-67 and column 2 lines 1-8).

However *Boulmakoul* does not explicitly disclose the inclusion of title evidence images in a system for producing specific title insurance commitments.

*SMS* discloses:

a database of title evidence images (page 2, 9<sup>th</sup> bullet and page 4, paragraph 1) in a system specifically designed to produce title insurance commitments (whole document).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* with *SMS* in order to build a more inclusive software suite containing title plant software in order to increase efficiency in title insurance research and document production.

6. **As to claim 2**, see the discussion of claim 1. Additionally, *SMS* further discloses the system of claim 1, further comprising an interface to a closing system (page 1, paragraph 3 and page 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* with *SMS* in order to build a more inclusive software suite containing an interface to closing software in order to increase efficiency in document production.

7. **As to claim 3**, *Boulmakoul* discloses a method of producing a commitment, the method comprising the steps of:

reducing a multi-jurisdictional set of textual clauses for minimum requisite and exclusionary language for a commitment to a locality specific subset of textual clauses (column 1, lines 36-61);

presenting said locality specific subset in selectable form (column 2 lines 4-8);

producing a commitment based upon said selected ones of said locality specific subset of textual clauses (column 1 lines 36-61).

*Boulmakoul* does not specifically disclose rendering title evidence images.

*SMS* discloses;

rendering at least one electronic image of title evidence to assist in at least one selection of said locality specific subset of textual clauses (page 1, paragraph 3 and page 2, 9<sup>th</sup> bullet).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* with *SMS* in order to facilitate an integration of title evidence images with title commitment writing software to expedite the title commitment writing process and comply with RESPA.

8. **As to claim 6**, *Boulmakoul* discloses a machine readable storage having stored thereon a computer program for producing a commitment (column 2 lines 26-29), the computer program comprising a routine set of instructions for causing the machine to perform the steps of:

reducing a multi-jurisdictional set of textual clauses for minimum requisite and exclusionary language for a commitment to a locality specific subset of textual clauses (column 1 lines 36-61);

presenting said locality specific subset in selectable form (column 2 lines 4-8),  
producing a commitment based upon said selected ones of said locality specific subset of textual clauses (column 1 lines 36-61).

However *Boulmakoul* does not explicitly disclose rendering title evidence images.

*SMS* discloses;

rendering at least one electronic image of title evidence to assist in at least one selection of said locality specific subset of textual clauses (page 2, Features section, 9<sup>th</sup> bullet and page 4, paragraph 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* with *SMS* in order to facilitate an integration of title evidence images with title commitment writing software modularized on a computer readable storage in order to expedite the title commitment writing process and comply with RESPA.

9. **Claims 4 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Boulmakoul* in view of *SMS* website in further view of the article "AIM for Windows 4.1 offers SureClose integration, other efficiency features: Visit Stewart at ALTA Tech 2003 for demonstration" by *Stewart Corp.* accessed via the website <http://www.stewart.com/page/aim-for-windows-4.1-offers-sureclose-integration-other-efficiency-features-visit-stewart-at-alta-tech-2003-for-demonstration>.



10. **As to claim 4**, see the discussion of claim 3. However, none of the references explicitly teach the method wherein a communications network is utilized. *Stewart Corp.* discloses the method, further comprising the step of performing said presenting, rendering and producing step over a computer communications network through a markup language document interface (page 1, particularly paragraphs 1 and 2 of text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* and *SMS* website with *Stewart Corp.* in order to offer additional flexibility in product offerings by utilizing markup language, such as html use over a network, to allow for, as *Stewart Corp.* suggests, access by all parties involved in a real estate transaction the latest data (page 1, paragraph 2, lines 3 and 4).

11. **As to claim 7**, see the discussion of claim 6, however, none of the references explicitly teach the method wherein a communications network is utilized. *Stewart Corp.* discloses the machine readable storage of claim 6, further comprising the step of performing said presenting, rendering and producing step over a computer communications network through a markup language document interface (page 1, particularly paragraphs 1 and 2 of text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* and *SMS* website with *Stewart Corp.* in order to offer additional flexibility in product offerings by utilizing markup language, such as html use over a network, to allow for, as *Stewart Corp.* suggests, access by all parties involved in a real estate transaction the latest data (page 1, paragraph 2, lines 3-4).

12. **Claims 5 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Boulmakoul* in view of *SMS* website and *TitleSolutions* accessed for the date 10/03/2002 via site

<http://webarchive.org/web/20021003211404/http://www.titlesolutions.com/>.

13. **As to claim 5**, See the discussion of claim 3. Additionally, *Boulmakoul* discloses the method, wherein said reducing step comprises the steps of:

identifying variable data (column 1 lines 52-61);

determining a locality based upon said identified variable data (column 1 lines 35-61); and,

reducing a multi-jurisdictional set of textual clauses for minimum requisite and exclusionary language for commitment to a locality specific subset of textual clauses based upon said determined locality (column 1 lines 35-61).

However, *Boulmakoul* does not explicitly describe that the variable data is real estate data. *TitleSolutions, Inc* discloses that the variable data is real estate data (paragraph 2)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* and *SMS* website with *TitleSolutions* to utilize an automatic method of document generation applied to a title commitment in order to facilitate increased employee workflow.

14. **With respect to claim 8**, see the discussion of claim 6. Additionally, *Boulmakoul* discloses the machine readable storage of claim 6, wherein said reducing step

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comprises the steps of:

identifying variable data (column 1 lines 52-61);

determining a locality based upon said identified variable data (column 1 lines 35-61); and,

reducing a multi-jurisdictional set of textual clauses for minimum requisite and exclusionary language for a commitment to a locality specific subset of textual clauses based upon said determined locality (column 1 lines 35-61).

However, *Boulmakoul* does not explicitly describe that the variable data is real estate data. *TitleSolutions, Inc* discloses that the variable data is real estate data (paragraph 2)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* and *SMS* website with *TitleSolutions* to utilize an automatic method of document generation applied to a title commitment in order to facilitate increased employee workflow.

15. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Boulmakoul* in view of *Standard Conveyancer—Millennium Edition* website accessed via <http://web.archive.org/web/20020814011312/www.standardsolutionsinc.com/conveyancer.htm> and *SMS*.

16. **As to claim 9**, *Boulmakoul* discloses a commitment computer program article of manufacture comprising:

an interface to locality specific textual clauses of minimal requisite and

exclusionary language, said locality specific textual clauses forming a subset of a database of multi-locality textual clauses of minimal requisite and exclusionary language (column 1 lines 36-61);

*Boulmakoul* does not disclose that the interface is a graphical user interface and that output format can be specified.

*Standard Conveyancer* discloses that the interface is a graphical user interface (page 3); and

at least one user interface widget disposed within said graphical user interface which can specify an output format from among a set of output formats for producing a title insurance commitment formed from a user selection of said locality specific textual clauses presented through said graphical user interface (first page, third page, also second page, first bullet).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* with *Standard Conveyancer* in order to reduce user training and increase intuitiveness and ease of use by utilizing a graphical user interface. It also would have been obvious to include the ability to output in multiple formats in order to allow for various organizational storage formats and various potential needs of the client/agent in facilitating the transaction.

*Boulmakoul* does not disclose an image viewer embedded in a graphical user interface.

*SMS* discloses:

an image viewer having an activatable link within said graphical user interface for viewing title evidence document images (page 1, paragraph 3 and page 2, 9<sup>th</sup> bullet).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Boulmakoul* with *SMS* in order to further aid productivity and streamline a software package by including title plant imaging software with title insurance commitment document composing software.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliza Squires whose telephone number is (571)270-7052. The examiner can normally be reached on Monday through Friday 8 am - 4 pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eliza Squires/  
Examiner, Art Unit 4156  
07/24/2008

/Charles R. Kyle/  
Supervisory Patent Examiner, Art Unit 4156